

ESTTA Tracking number: **ESTTA364231**

Filing date: **08/20/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

### Opposers Information

Name	Tenor Trademarks Limited
Granted to Date of previous extension	08/21/2010
Address	c/o 9595 Wilshire Blvd.Suite 305 Beverly Hills, CA 90212 UNITED STATES

Name	The 3 Tenors Limited
Granted to Date of previous extension	08/21/2010
Address	c/o 9595 Wilshire Blvd.Suite 305 Beverly Hills, CA 90212 UNITED STATES

Name	Placido Domingo
Granted to Date of previous extension	08/21/2010
Address	c/o 9595 Wilshire Blvd.Suite 305 Beverly Hills, CA 90212 UNITED STATES
Party who filed Extension of time to oppose	PlacidoDomingo
Relationship to party who filed Extension of time to oppose	There was no space between the first and last names. I added the space.

Name	Jose Carreras
Granted to Date of previous extension	08/21/2010
Address	c/o 9595 Wilshire Blvd.Suite 305 Beverly Hills, CA 90212 UNITED STATES
Party who filed Extension of time to oppose	JoseCarreras
Relationship to	There was no space between the first and last names. I added the space.

party who filed Extension of time to oppose	
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Name	Estate of Luciano Pavarotti
Granted to Date of previous extension	08/21/2010
Address	c/o 9595 Wilshire Blvd.Suite 305 Beverly Hills, CA 90212 UNITED STATES

Attorney information	Mark Robertson FUNSTEN & FRANZEN 9595 Wilshire Blvd.Suite 305 Beverly Hills, CA 90212 UNITED STATES mrobertson@lawff.com Phone:310.785.1710
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### Applicant Information

Application No	77873934	Publication date	06/22/2010
Opposition Filing Date	08/20/2010	Opposition Period Ends	08/21/2010
Applicant	Ballen, Gary 6465 Lubao Ave Woodland Hills, CA 91367 UNITED STATES		

### Goods/Services Affected by Opposition


Class 041. All goods and services in the class are opposed, namely: Entertainment, namely, production of a television show featuring music
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### Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2348877	Application Date	06/30/1994
Registration Date	05/09/2000	Foreign Priority Date	NONE
Word Mark	THE 3 TENORS IN CONCERT 1994 CARRERAS DOMINGO PAVAROTTI		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1994/06/00 First Use In Commerce: 1994/06/00 series of prerecorded [ phonograph records, ] audio and video [ cassette tapes and ] discs [ and motion picture films ] featuring performances by a musical group [ and musical documentaries ]

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	The marks "The 3 Tenors" and "The Three Tenors" and their accompanying designs have been registered in several countries. Please see Exhibit B to the attached Notice of Opposition		
Goods/Services	Musical, radio, dramatic and television entertainment; inter alia. Please see Exhibit B to the attached Notice of Opposition for international classifications of the various registrations		

Attachments	74546442#TMSN.gif ( 1 page )( bytes ) Notice of Opposition to App. No. 77873934 The New Three Tenors.pdf ( 11 pages )(78399 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Mark Robertson/
Name	Mark Robertson
Date	08/20/2010

**IN THE UNITED STATE PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re the Application of Gary Ballen

Serial No.: 77/873,934

Filed: November 17, 2009

Trademark: **THE NEW THREE TENORS** (standard character mark)

Published: June 22, 2010

TENOR TRADEMARK LIMITED, )  
a company organized and existing under )  
the laws of Jersey, Channel Islands; THE )  
3 TENORS LIMITED, a company )  
organized and existing under the laws of )  
England and Wales; PLACIDO )  
DOMINGO, an individual; JOSE )  
CARRERAS, an individual; THE )  
ESTATE OF LUCIANO PAVAROTTI; )

Opposer,

v.

Gary Ballen,  
an individual,

Applicant.

OPPOSITION NO.: \_\_\_\_\_

**NOTICE OF OPPOSITION**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Dear Sir or Madam:

TENOR TRADEMARKS LIMITED, a company organized and existing under the laws of Jersey, Channel Islands, with its place of business at Oak Walk, St. Peter, Jersey,

JE3 7EF (“TTL”); THE 3 TENORS LIMITED, a company organized under the laws of England and Wales (“3TL”), c/o Funsten & Franzen, 9595 Wilshire Blvd., Suite 305, Beverly Hills, California 90212; PLACIDO DOMINGO, an individual and citizen of Spain (“Domingo”), c/o Funsten & Franzen, 9595 Wilshire Blvd., Suite 305, Beverly Hills, California 90212; JOSE CARRERAS, an individual and citizen of Spain (“Carreras”), c/o Funsten & Franzen, 9595 Wilshire Blvd., Suite 305, Beverly Hills, California 90212; and THE ESTATE OF LUCIANO PAVAROTTI (“Pavarotti” refers to the individual Luciano Pavarotti, now deceased), c/o Funsten & Franzen, 9595 Wilshire Blvd., Suite 305, Beverly Hills, California 90212 (collectively, “Opposers”) believe that they will be damaged by the registration by Gary Ballen, an individual, (“Applicant”) of the mark THE NEW THREE TENORS for “Entertainment, namely, production of a television show featuring music,” in International Classification 41, as shown in Application Serial No. 77/873934 (the “Application”).

Opposers believe they will be damaged by registration of Applicant’s mark because Opposers own, control, are interested in, and/or are uniquely associated with several international trademark registrations (including U.S. Registration No. 2,348,877) and common law trademarks and Applicant’s mark is likely to cause confusion among and deceive the consumer public and relevant industry with regard to Opposers’ registered and common law trademarks. Further, purchasers familiar with Opposers’ goods and entertainment services are likely to mistakenly believe that Applicant’s goods and/or services are sponsored by, authorized, endorsed, affiliated with or otherwise approved by Opposers.

Applicant's mark was published for opposition on June 22, 2010, and Opposers filed for and received a thirty (30) day extension of time to oppose, which extended the time for opposition to August 21, 2010. Therefore, in accordance with the provisions of Section 13 of the Trademark Act (15 U.S.C. § 1063), Opposers hereby oppose Application Serial No. 77/873934.

As grounds for this opposition, Opposers allege as follows:

**Factual and Procedural Background**

1. In July 1990, the world's three most famous and accomplished operatic tenors, José Carreras, Plácido Domingo, and Luciano Pavarotti, began performing under the names "The Three Tenors" and "The 3 Tenors" ("The Three Tenors"). This acclaimed collaboration spawned the creation and worldwide distribution and exploitation of live musical performances, television programs, home videos and DVDs, and the recording of phonorecords, and continues to generate opportunities for exploitation of the various properties Opposers own and/or control. Since then, Opposers have been and are currently engaged in the business of managing, exploiting, protecting, and licensing the intellectual property associated with the worldwide entertainment services of The Three Tenors, and each and all of Opposers have a real interest therein.

2. TTL owns U.S. Registration No. 2,348,877 for the design mark "THE 3 TENORS IN CONCERT 1994 CARRERAS DOMINGO PAVAROTTI" in connection with a "series of prerecorded phonograph records, audio and video cassette tapes and discs, and motion picture films featuring performances by a musical group and musical documentaries" in International Class 9 (the "U.S. Mark"). The U.S. Mark was applied

for on June 30, 1994 and registered on May 9, 2000. A copy of the registration certificate is attached as Exhibit “A.”

3. TTL and 3TL are also the owners of numerous trademark registrations in several countries in classes, including Nice Classification 41 for “musical, radio, dramatic and television entertainment” (collectively, the “International Marks”). A partial list of these registered trademarks is attached as Exhibit “B.” TTL and/or 3TL own these registrations and the trademarks shown thereby and all of the business goodwill connected with them, each being valid and in full force and effect.

4. “Marks” refers collectively to the U.S. Mark and the International Marks.

5. Domingo, Carreras, and Pavarotti are uniquely associated with the Marks, as each individual was famous worldwide prior to the collaboration and it was their collaboration that brought notoriety and fame to the phrases “The Three Tenors” and “The 3 Tenors.”

6. Since the adoption and use of the Marks, Opposers have made and continue to make substantial and continuous use of the Marks in interstate commerce and internationally on and in connection with the creation, development, production, advertising, promotion, distribution, and performance of live musical events, recordings of live musical events for television and film, and the recording of phonorecords, both live and in studio.

7. The Marks are famous marks, having achieved widespread recognition among the consumer public. They are strong, well known, and of great value to Opposers. In the mind of the consumer public and the relevant industry, the Marks

identify and designate Opposers' goods and services and distinguish them from the goods and services of others.

**Applicant's Mark Is Likely to Deceive Consumers and Cause Consumer Confusion and Mistake**

8. The goods and services in the Application currently are listed as entertainment services, namely "production of a television show featuring music." The original application identified the goods and services as "production of The New Three Tenors Program." The goods and services identified in the Application are identical to, closely related to, and/or in the natural zone of expansion of Opposers' goods and services.

9. Upon information and belief, Applicant's goods and services will be produced, marketed, and distributed through the same or similar channels of trade and to the same classes of consumers as Opposers' goods and services.

10. Applicant's mark so resembles the Marks in appearance, sound, connotation, and commercial impression as to be likely, when used on or in connection with Applicant's goods and/or services, to cause confusion and/or mistake and to deceive consumers and the relevant industry.

11. Opposers' various registrations of the Marks have been registered for more than a decade for goods and services first rendered in interstate commerce and internationally in the early 1990s. Applicant has not used its mark in interstate commerce and submitted an intent-to-use application on November 17, 2009. Thus, priority is not an issue in this case: Opposers have priority of use and the Marks have seniority, and any and all actual or likelihood of confusion is and will be attributable to Applicant's mark, which is the junior mark.

**Applicant's Mark Suggests a Connection with Persons Living and Deceased**

12. The Marks have been and continue to be widely associated with three individuals: Carreras, Domingo, and Pavarotti, the latter of which is deceased.

13. As a result of this widespread recognition, the consumer public is likely to mistakenly believe that Applicant's mark is connected to any, some, or all of Carreras, Domingo, and Pavarotti. No such connection in fact exists, as whatever goods and/or service Applicant seeks to produce are not sponsored or endorsed by Carreras, Domingo, or their representatives, Pavarotti's estate, TTL, or 3TL.

**Applicant's Mark Will Dilute the Marks**

14. The Marks enjoy widespread recognition with the consumer public and the relevant industry and are all and each of them famous marks.

15. As a result of the similarity of Applicant's mark to the Marks, and the proximity of the goods and services identified in the Application and those of Opposers, Applicant's mark will impair the distinctiveness of the Marks as origins of Opposers' goods and services.

WHEREFORE, Opposers pray that this opposition be sustained and that registration of Applicant's mark THE NEW THREE TENORS, as shown in Application Serial No. 77/873,93, be refused.

Please recognize as an additional attorney for Opposers Don Erik Franzen and the law firm of Funsten & Franzen, 9595 Wilshire Blvd., Suite 305, Beverly Hills, California

90212. Please address all communications to Mark Robertson of Funsten & Franzen at the address set forth below.

Respectfully submitted,

FUNSTEN & FRANZEN

Dated: August 20, 2010

By: 

Mark Robertson, Esq.

9595 Wilshire Blvd., Ste. 305

Beverly Hills, CA 90212

T: 310.785.1710

F: 310.785.1720

mrobertson@lawff.com

*Attorneys for Opposers Tenor Trademarks  
Limited, The 3 Tenors Limited, Plácido  
Domingo, Jose Carreras, and the Estate of  
Luciano Pavarotti*

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,348,877

**United States Patent and Trademark Office**

Registered May 9, 2000

**TRADEMARK  
PRINCIPAL REGISTER**



TENOR TRADEMARKS LIMITED (CHANNEL  
ISLANDS COMPANY)  
OAK WALK  
JERSEY, CHANNEL ISLANDS

FOR: SERIES OF PRERECORDED PHONO-  
GRAPH RECORDS, AUDIO AND VIDEO CAS-  
SETTE TAPES AND DISCS AND MOTION PIC-  
TURE FILMS FEATURING PERFORMANCES  
BY A MUSICAL GROUP AND MUSICAL DOC-  
UMENTARIES, IN CLASS 9 (U.S. CLS. 21, 23,  
26, 36 AND 38).

FIRST USE 6-0-1994; IN COMMERCE  
6-0-1994.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "THE 3 TENORS IN CONCERT  
1994", APART FROM THE MARK AS SHOWN.

THE NAMES "CARRERAS", "DOMINGO"  
AND "PAVAROTTI" IDENTIFY LIVING INDI-  
VIDUALS WHOSE CONSENT IS OF RECORD.

SN 74-546,442, FILED 6-30-1994.

MARTHA SANTOMARTINO, EXAMINING AT-  
TORNEY

**PARTIAL LISTING OF OPPOSERS' INTERNATIONAL  
TRADEMARK REGISTRATIONS**

<b>Country</b>	<b>Mark</b>	<b>Registration Number</b>	<b>Registration Date</b>	<b>Class</b>
Australia	The 3 Tenors and design	632480	4/27/97	41
Australia	The 3 Tenors and design	632479	3/11/97	9
Benelux	The Three Tenors	539156	7/1/94	9
Benelux	The 3 Tenors and design	542055	9/1/94	9, 38, 41
European Union	The 3 Tenors and design	003017951	6/3/04	9, 25, 41
Germany	The 3 Tenors and design	2901778	3/31/95	9, 36, 41
Ireland	The Three Tenors	161840	10/15/93	9
Japan	The 3 Tenors and design	4065768	9/8/95	25
Japan	The 3 Tenors and design	4164639	9/8/95	16
Japan	The 3 Tenors and design	3347511	9/8/95	26
Japan	The 3 Tenors and design	4043591	9/8/95	28
Japan	The 3 Tenors and design	4693865	10/16/02	41
Philippines	The 3 Tenors and design	41994097717	1/25/01	41
Philippines	The 3 Tenors and design	41994097716	1/16/01	9
Singapore	The 3 Tenors and design	T9405039G	6/17/94	9
Singapore	The 3 Tenors and design	T9405040J	6/17/94	41
Spain	The 3 Tenors and design	2102782	12/1/98	16
Spain	The 3 Tenors and design	2102783	12/1/98	25
Spain	The 3 Tenors and design	2102784	12/1/98	26
Spain	The 3 Tenors and design	2102785	12/1/98	28

Spain	The 3 Tenors and design	2102786	12/1/98	38
Spain	The 3 Tenors and design	2102787	1/1/99	41
United Kingdom	The 3 Tenors and design	1573843	5/7/99	9, 41
United Kingdom	The 3 Tenors and design	2032570	11/14/97	16, 25, 26, 28, 41
United Kingdom	The 3 Tenors and design	2102572	9/19/97	38

**PROOF OF SERVICE**

STATE OF CALIFORNIA                    )  
  )  
COUNTY OF LOS ANGELES                )

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is 9595 Wilshire Blvd., Ste. 305, Beverly Hills, California 90212.

On August 20, 2010, I served the foregoing document described as NOTICE OF OPPOSITION on all concerned parties in this action by:

[X] placing ( ) the original (X) a true copy thereof enclosed in sealed envelopes addressed as follows:

Gary Ballen  
6465 Lubao Ave.  
Woodland Hills, CA 91367-2714

[X] BY MAIL I caused such envelope to be deposited in the mail at Beverly Hills, California. The envelope was mailed with postage thereon fully prepaid. I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. It is deposited with the U.S. postal service on that same day in the ordinary course of business. I am aware that on motion of party served, service is presumed invalid if postal cancellation date or postage meter day is more than 1 day after date of deposit for mailing in affidavit.

[ ] I caused delivery by Federal Express of the document(s) listed above by next business day, by placing the true copies in separate envelopes for each addressee, with the name and address of the person served shown on the envelope and by sealing the envelope and placing it for collection and delivery, with delivery fees paid or provided for in accordance with ordinary business practices.

[ ] BY PERSONAL DELIVERY TO : I caused the foregoing document to be personally delivered to the Addressee at the address set forth above.

[ ] BY FACSIMILE TRANSMISSION I caused the foregoing document to be transmitted by facsimile to the telephone number known by me to be regularly available for receipt of facsimile transmissions by the Addressee.

[X] (State) I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on August 20, 2010, at Los Angeles, California.



Mark Robertson